

REMARKS

Applicant respectfully requests reconsideration. Claims 1-31 were previously pending in this application, with claims 8-10, 14-15 and 20-31 being withdrawn. By this amendment, Applicant is canceling claims 2, 8-10, 14-15 and 20-31 without prejudice or disclaimer. Applicant reserves the right to file the canceled claims in a continuing application. Claims 1, 3-5, 11 and 16-17 are being amended. New claims 32-34 are being added. As a result, claims 1, 3-7, 11-13, 16-19, and 32-34 are pending for examination with claims 1, 11, 16 and 34 each being independent claims. No new matter has been added.

Applicant notes that an Article 34 amendment was submitted during the PCT stage of the application. It appears that the Office Action addresses the claims as filed in the PCT stage instead of the amended claims included in the Article 34 amendment. Accordingly, the claims listing shown herein is based on the claims as filed in the PCT stage, and the amendments are shown relative to the claims as filed.

New dependent claim 32 was included in the Article 34 amendment as a new claim.

New independent claim 34 was included in the Article 34 amendment as a new claim, and is included herein with additional limitations, namely that features of the first and second configurations of the exposed portion of the electrically conductive element are recited.

Claim 1

Goldhaber

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,234,429 to Goldhaber (hereinafter, "Goldhaber").

Claim 1 recites, among other features, an ablation electrode having an outer surface, wherein the electrode is convertible from a first configuration in which the electrode outer surface has a first axial size and a first radial size to a second configuration in which the electrode outer surface has a second axial size and maintains the first radial size.

According to the Office Action, Goldhaber each tube (20) of electrode (14) is an electrode portion because each tube is electrically connected to the operative tip. Without acceding to the propriety of the rejection, claim 1 is being amended to recite that the ablation electrode has an outer

ablating surface. Amended claim 1 further recites that in a first configuration the electrode outer ablating surface has a first axial size, and in a second configuration, the electrode outer ablating surface has a second axial size. The tubes (20) of electrode (14) in Goldhaber do not have outer ablating surfaces because they are covered with insulation which is sufficient to prevent ablation as described in col. 3, lines 13-15 of Goldhaber. Accordingly, withdrawal of the rejection of claim 1 over Goldhaber is respectfully requested.

Each of claims 3-7 depends either directly or indirectly from claim 1, and withdrawal of the rejections of these claims over Goldhaber is respectfully requested for at least the same reasons provided above for claim 1.

Silvestrini

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by WO 95/20360 to Silvestrini (hereinafter, "Silvestrini").

Without acceding to the propriety of the rejection, claim 1 has been amended to include the limitations of dependent claim 2, including the recitation that the ablation electrode comprises a first electrode portion and a second electrode portion, and that in a first configuration more of the second electrode portion length is contained within the first electrode portion than in a second configuration. Claim 2 also stands rejected over Silvestrini. According to the Office Action, Silvestrini teaches an ablation electrode that has a first electrode portion (2) and a second electrode portion (4) in Figure 3. Applicants respectfully disagree.

Silvestrini describes a bipolar electrode configuration, including an inner electrode (4), and a separate, outer electrode (2). Amended claim 1 recites that the ablation electrode comprises a first electrode portion and a second electrode portion, thereby requiring that the first and second electrode portions be part of the same electrode. As described on page 10, lines 16-20 of Silvestrini, the electrodes in the bipolar configuration of Silvestrini are separate electrodes:

For all cases, after the electrode surface is optimally placed in contact with the neoplastic mass, radio frequency energy is applied to one of the contacting electrodes and is allowed to

pass from the energy-supplied electrode through the neoplastic mass, to the other electrode, thereby cutting or ablating it depending on the amount of energy utilized.

Because Silvestrini does not disclose an ablation electrode having first and second electrode portions wherein in a first configuration more of the second electrode portion length is contained within the first electrode portion than in a second configuration, withdrawal of the rejection of claim 1 over Silvestrini is respectfully requested.

Each of claims 3-7 depends either directly or indirectly from claim 1, and withdrawal of the rejections of these claims over Silvestrini is respectfully requested for at least the same reasons provided above for claim 1.

Claim 11

Silvestrini

Claim 11 stands rejected under 35 U.S.C. §102(b) as being anticipated by Silvestrini. According to the Office Action, the outer ablating surface area of ablation electrode (2) is adjustable because the electrode portions are telescopically slidable relative to one another.

Without acceding to the propriety of the rejection, claim 11 has been amended to recite, among other features, an ablation electrode having an electrode length, wherein the ablation electrode length is adjustable. Claim 11 also separately recites that an outer ablating surface area length of the electrode is adjustable. Silvestrini does not disclose adjusting the ablation electrode length because the respective lengths of outer electrode cylinder (2) and inner electrode rod (4) remain the same when the electrodes and/or their insulation sheaths slide relative to one another. Accordingly, withdrawal of the rejection of claim 11 over Silvestrini is respectfully requested.

Each of claims 12 and 13 depends either directly claim 11, and withdrawal of the rejections of these claims over Silvestrini is respectfully requested for at least the same reasons provided above for claim 11.

Goldhaber in view of Eggers

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Goldhaber in view of U.S. Patent No. 5,810,764 to Eggers (hereinafter, "Eggers"). According to the Office Action, the outer ablating surface area of the Goldhaber device is adjustable because the operative tip portion (16) is adjustable. To support this contention, the Office Action points to a section of Goldhaber which describe that the distance of the operative tip (16) from the handle is adjustable.

Without acceding to the propriety of the rejection, claim 11 has been amended to recite that the electrode has an outer ablating surface area which has a length, and the outer ablating surface area length is adjustable. Goldhaber does not disclose that the length of operative tip 16 is adjustable. Accordingly, withdrawal of the rejection of claim 11 over Goldhaber in view of Eggers is respectfully requested.

Each of claims 12 and 13 depends either directly claim 11, and withdrawal of the rejections of these claims over Goldhaber in view of Eggers is respectfully requested for at least the same reasons provided above for claim 11.

Claim 16

Claim 16 stands rejected under 35 U.S.C. §102(b) as being anticipated by Goldhaber. According to the Office Action, a second portion of an ablation electrode (as shown in annotated Figure 2 on page 4 of the Office Action) is moveable from a first position substantially inside a first ablation electrode portion to a second position substantially outside the first ablation electrode portion.

Without acceding to the propriety of the rejection, claim 16 has been amended to recite that the first ablation electrode portion has an outer ablating surface configured to emit electrical energy, and further that the second ablation electrode portion has an outer ablating surface configured to emit electrical energy. The first and second electrode portions shown in annotated Figure 2 of the Office Action do not have outer ablating surfaces because these tubes (20) have outer surfaces with layers of electrically insulating material (see col. 3, lines 13-15 of Goldhaber). Accordingly, withdrawal of the rejection of claim 16 is respectfully requested.

Each of claims 17-19 depends either directly or indirectly from claim 16, and withdrawal of the rejections of these claims is respectfully requested for at least the same reasons provided above for claim 16.

New Claims

New dependent claim 32 depends from claim 16, and recites that the first ablation electrode portion and the second ablation electrode portion are electrically connected. Support for this claim may be found throughout the specification, including, for example, at page 8, lines 17-23.

New dependent claim 33 depends from claim 1, and recites that the first electrode portion is in electrical contact with an electrical lead, and the second electrode portion is in electrical contact with the same electrical lead. Support for this claim may be found throughout the specification, including, for example, at page 8, lines 22-23.

New independent claim 34 is directed to a catheter including an electrically conductive element which is convertible from a first configuration, in which an exposed portion of the electrically conductive element has a first axial length and a first radial size along a first axial section of the shaft, to a second configuration in which the exposed portion of the electrically conductive element has a second, longer axial length and maintains the first radial size along the first axial section of the shaft. Support for this claim may be found throughout the specification, including, for example in Figures 2 and 3, and at page 8, lines 3-16 and 24-31.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance and a Notice of Allowance is respectfully requested. If the Examiner believes that minor clarifying amendments to the claim would be helpful, the Examiner is requested to call the undersigned at the telephone number listed below.

In the event the U.S. Patent and Trademark Office determines that an extension is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to please charge our Deposit Account No. 23/2825 under Docket No. B1075.71014US01 from which the undersigned is authorized to draw.

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Respectfully submitted,

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